

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Fumiyasu HIRAI et al.

Serial No. 09/961,265

Filed: September 25, 2001

For: **ADSORBENT, ADSORBING AND REMOVING PROCESS AND ADSORBER FOR ENDOGENOUS CANNABINOID**



Group Art Unit: 1724

Examiner: Ivars C. Cintins

1724
A/BM
#5
7-3-02

AMENDMENT

Commissioner for Patents
Washington, D.C. 20231

Date: June 27, 2002

Sir:

In response to the Office Action dated March 28, 2002, please amend the above-identified application as follows:

IN THE CLAIMS:

Please cancel claims 1-4 and 7.

REMARKS

Claims 5 and 6 are pending in the present application. Claims 5 and 6 are rejected.

Rejections under 35 U.S.C. §102(a) and (b)

Claims 1-4 and 7 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,057,161 to Nau, filed October 27, 1997. The Examiner asserts that the styrene divinylbenzene resin of the reference is the same as that disclosed by Applicants, and therefore that this reference

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material will inherently have the recited solubility parameter and affinity for endogenous cannabinoids.

Claims 1 and 3-7 are rejected under 35 U.S.C. §102(a) as being anticipated by EP 1110602, filed April 26, 2000; published June 27, 2001. The Examiner asserts that the referenced material (based on page 2, final 2 lines) is identical to that disclosed by Applicants, and will therefore inherently have the recited solubility parameter.

Claims 1-4 and 7 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,625,652 to Fujimoto et al. The Examiner asserts that the styrene divinylbenzene resin of the reference is identical to that disclosed by Applicants, and will therefore inherently have the recited solubility parameter and affinity for endogenous cannabinoids.

Claims 1-4 and 7 are further rejected under 35 U.S.C. §102(b) as being clearly anticipated by U.S. Patent No. 4,425,237 to Abe et al.

Applicants herein cancel claims 1-4 and 7 in order to overcome the rejection.

With respect to the rejection of remaining Claims 5 and 6 as being anticipated by EP 1110602, Applicants note that the present invention was filed on September 25, 2001, but is based on JP 2000-296436 filed September 28, 2000. Applicants note that they may not yet rely upon the foreign priority paper to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55.

Applicants herein submit an English translation of certified copy of Japanese Patent Application No. 2000-296436 in order to overcome the rejection. Subsequently, Applicants submit that this priority document pre-dates the EP111062 reference, thus rendering the rejection moot.

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For at least the foregoing reasons, Applicants submit that there is no suggestion to combine the cited reference and the admitted prior art, and that the claimed invention as amended distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

Should the Examiner deem that any further action by Applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone Applicants' undersigned attorney.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees which may be due with respect to this paper, may be charged to Deposit Account No. 01-2340.

Respectfully submitted,

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Attachment: Verified Translation of Appln. No. JP 2000-296436

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